



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,908	11/16/2001	David Strutt	02310.0054	7906
22852	7590	07/24/2008	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ROBERTSON, DAVID	
			ART UNIT	PAPER NUMBER
			3623	
			MAIL DATE	DELIVERY MODE
			07/24/2008 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/987,908

**Applicant(s)**

STRUTT ET AL.

**Examiner**

Dave Robertson

**Art Unit**

3623

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 31, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 31, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is a Non-final office action after the filing of a Request for Continuation (RCE) on 5/29/2008. Claims 1-16, 31, 34 and 35 are pending.

### ***Continued Prosecution Application***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/29/2008 has been entered.

### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 5/29/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent issued on US Application No. 09/987,905 has been reviewed and is accepted.

The terminal disclaimer has been recorded.

***Response to Amendment***

4. Applicant amends claims to address rejections under 35 U.S.C. 112, second paragraph, and 35 U.S.C 101 as made in the Final office action of 3/31/2008. However, the claims continue to claim nonstatutory subject matter and invoke *new issues* with regard to the indefiniteness of the claims. The amendments are addressed below in the revised and extended rejections under 112 and 101.

***Response to Arguments***

5. Applicant's arguments filed 5/29/2007 have been fully considered but they are not persuasive:

6. Applicant argues claims 1-16, 31, 34, and 35 as amended are statutory under 35 U.S.C. 101 because the claims now recite "a data structure recorded on a computer readable medium or executed in a computer processor...", Applicant asserting that a data structure recorded on a computer readable medium defines structural and functional relationships and are thus statutory. (Remarks, page 9).

Examiner respectfully disagrees: Nonfunctional descriptive material, even if recorded on computer-readable medium, remains non-statutory if no requisite functionality with or among the data structures is present. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. Diehr, 450 U.S. at 185-86, 209 USPQ at 8. In the claims presented here, the *set of dimensions...*; *set of measures...*; and *relationships...* remain both abstract idea at

the least, and nonfunctional data at best: *sets of dimensions* and *sets of measures* are data and *representing* is a descriptor imparting no functionality within or among the claimed arrangement of data.

7. Accordingly, the grounds of rejection as in the prior office action are maintained, revised and extended as per present amendments.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-16, 31, 34, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites: *A business model recorded on a computer readable medium or executed in a computer processor...* However, it is unclear as to what Applicant is claiming as the statutory class of invention because a *computer readable medium* is a product claim while a *business model...executed in a computer processor* suggests a process claim. Applicant appears to claim two different statutory classes of invention, the indefiniteness of the claim further exacerbated by the abstraction of "a business model" as it is unclear how a *business model* is *executed on a processor*. Claims 2-16 do not cure the deficiencies of the parent claim and are therefore indefinite as well.

Claim 31 recites: *A dimensional framework recorded on a computer readable medium or executed in a computer processor...* However, "a dimensional framework"

claimed is no more clear than claims to "a business model" as product or process as in claim 1.

Claims 34 and 35 recite: *A computer program product recorded on a computer readable medium for use in a computer implementing a data warehouse...* However, it is unclear as to what Applicant is claiming as Applicant appears to be claiming a *product* recorded on *another product* (the computer readable medium), the product to be used in a computer, the computer implementing a data warehouse. The preamble concludes claiming a data warehouse *system* comprising *sets of data* and *relationships*, whereas the body of the claim does not recite any method steps of a computer program nor structure of any system. Therefore, even taking as an interpretation an attempt to claim computer program *instructions* stored on a computer readable medium or a *system*, it would difficult to find steps or acts carried out by a computer program or apparatus.

Amendment or cancellation of all claims is requested.

### ***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-16, 31, 34 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims to mere arrangements of data are non-statutory under 35 U.S.C. 101. Mere claiming of

Art Unit: 3623

nonfunctional descriptive material in a computer does not make it statutory. See MPEP 2106.01 [R-5].

An invention is statutory subject matter if the invention as a whole: a) falls into one of the statutory classes of invention (process, machine, manufacture, or composition of matter); and b) is useful (has a particular use or advantage conferring a benefit); and c) is not a judicially created exception to patentable subject matter (law of nature, abstract idea, or natural phenomenon) without practical application; and d) does not preempt all uses of a judicially created exception to patentable subject matter. MPEP [r5] § 2106 Patent Subject Matter Eligibility.

Nonfunctional descriptive material, even if recorded on computer-readable medium, remains non-statutory if no requisite functionality with or among the data structures is present. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8.

Claim 1 recites: *A business model...comprising a set of dimensions... a set of measures... and relationships between the set of dimensions and measures...* As such, the claim is directed to a mere arrangement of data without function. Claims 2-16 recite further arrangements of data (e.g. groupings of dimensions). Similarly, Claim 31 recites: *A dimensional framework..comprising...a set of dimensions...* Because these claims do not fall within a statutory class of subject matter, process, machine, manufacture, or composition of matter, they are non-statutory.

Claims 34 and 35 embody the non-functional descriptive material of claims 1 and 31 as "computer program product." Still, non-functional descriptive material, even if recorded on computer-readable medium, remains non-statutory if no requisite functionality with or among the data structures thus created is present. Applicant claims no functionality, e.g. "representing" is a non-functional descriptor imparting abstract meaning but no functionality within or on the claimed arrangement of data.

Applicant is advised that this is not merely an issue with the preamble of the claims. Alternatively claiming "A system..." rather than "A business model..." with the same recited elements would not render the claims statutory, as no functionality will have been recited with or among the elements of the claim.

Amendment or cancellation of the claims is requested.

### ***Conclusion***

12. Because of the indefiniteness of the claims, and as well the present invention as claimed being nonstatutory subject matter without recourse to an interpretation which could be taken for clear examination on the merits, no rejections as to 35 U.S.C. 102/103 are entered. Examining claims 1-16, 34, and 35 with respect to prior art would require speculation as to applicant's intent as to which statutory class of invention is being claimed and, even if assuming a class of invention, what structural or functional steps or acts would apply and would be searched. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection on these assumptions).

However, while no rejections under 35 U.S.C. 102/103 are currently entered, this is not an indication that such prior art rejections would not be entered (i.e. claims are not indicated herein as allowable by omission) given clear definition of statutory subject matter by Applicant amendments in a future response.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is (571)272-8220. The examiner can normally be reached on 9 am to 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dave Robertson/  
Examiner, Art Unit 3623

/Beth Van Doren/  
Supervisory Patent Examiner, Art Unit 3623